

REMARKS

Claims 1-27 are pending. Claims 1, 25, 26, and 27 are independent claims.

The Office Action includes a restriction requirement. The relevant portion of the Office Action is reproduced below:

“This application contains claims directed to the following patentably distinct species of the claimed invention:

- I. FIG. 1A
- II FIG. 5
- III. FIG. 7A
- IV. FIG.8
- V. FIG.9
- VI. FIG. 10A
- VII. FIG. 10B

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.”

Office Action, p. 2.

The applicant respectfully traverses the restriction requirement. Further, for the reasons discussed below, the applicant respectfully requests a withdrawal of the restriction requirement under 37 CFR 143 because the restriction requirement is invalid.

The restriction requirement is invalid for failing to identify the claims to which the restriction requirement applies and for failing to even assert the reasons for which the restriction is required.

A requirement for restriction is valid only

"[i]f two or more **independent and distinct** inventions are **claimed** in a single application, the examiner in an Office action will require the applicant in the reply to that action to elect an invention to which the **claims** will be restricted, this official action being called a requirement for restriction (also known as a requirement for division)."

37 CFR 1.142(a) (bold added). Further,

"[i]n the first action on an application containing a generic **claim** to a generic invention (genus) and **claims** to more than one patentably distinct species embraced thereby, the examiner may require the applicant in the reply to that action to elect a species of his or her invention to which his or her **claim** will be restricted if no **claim** to the genus is found to be allowable. However, if such application contains claims directed to more than a reasonable number of species, the examiner may require restriction of the claims to not more than a reasonable number of species."

37 CFR 1.142(a) (bold added).

In fact, the MPEP requires that

"[t]he **particular reasons** relied on by the examiner for holding that the inventions as claimed are either independent or distinct **should be concisely stated**. A **mere statement of conclusion is inadequate**. The reasons upon which the conclusion is based should be given ... The separate inventions should be **identified by a grouping of the claims** with a **short description of the total extent of the invention claimed in each group**, specifying the type or relationship of each group as by stating the group is drawn to a process, or to subcombination, or to product, etc., and should indicate the classification or separate status of each group, as for example, by class and subclass."

MPEP 815 (bold added). Moreover, MPEP requires that the restriction requirement include the following:

- (A) Statement of the requirement to restrict and that it is being made under 35 U.S.C. 121
 - (1) **Identify each group by Roman numeral.**
 - (2) **List claims in each group.** Check accuracy of numbering of the claims; look for same claims in two groups; and look for omitted claims.

(3) Give short description of total extent of the subject matter claimed in each group, pointing out critical claims of different scope and identifying whether the claims are directed to a combination, sub-combination, process, apparatus, or product.

(4) Classify each group."

MPEP 817 (bold added).

The restriction requirement is invalid because, *inter alia*, the Office Action fails to meet any of the above requirements for a proper and valid restriction requirement.

It is axiomatic that inventions are defined by the **Claims**. The Rules, MPEP, and logic dictate that a restriction requirement (requiring the applicant to elect one invention among alleged plurality of claimed inventions) should identify or group the claims such that the applicant may make a reasonable choice among the alleged plurality of claimed inventions, or make a reasonable argument that the grouping of the claims (thus the inventions) is incorrect.

Here, the Office Action violates the Rules, MPEP, and logic by failing to even allege that more than one invention is **claimed**. Namely,

1. The Office Action fails to group the alleged species of claims;
2. The Office Action fails to list claims in each group;
3. The Office Actions fails to classify such groups of claims; and
4. The Office Action fails to give short descriptions of total extent of the subject matter claimed in each group. In fact, **there is no discussion whatsoever of the particular reasons** for which the examiner is asserting that the inventions as claimed are either **independent or distinct**.

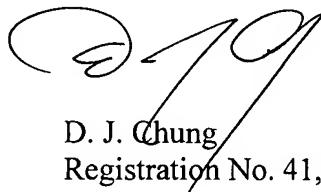
In short, the Office Action fails to identify the inventions (Claims) that it appears to be asserting are **independent and distinct**. Thus the applicant remains uninformed as to what the applicant's options are as to which claims are allegedly distinct and independent from which other claims.

Notwithstanding the fact that the restriction requirement is facially invalid, in order to comply with 37 CFR 1.111 and 1.143, the applicant provisionally elects, without prejudice and reservations of rights, the invention as recited by Claims 1-27 for further prosecution.

CONCLUSION

In view of the foregoing Remarks, the applicant respectfully submits that the entire application is in condition for allowance. The applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,



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